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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,786	08/01/2003	JungMan Yoon	1254-0232P	1678

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EXAMINER	
WARE, DEBORAH K	

ART UNIT	PAPER NUMBER
1651	

DATE MAILED: 04/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/631,786	YOON, JUNGMAN	
	Examiner	Art Unit	
	Deborah K. Ware	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-9 are presented for reconsideration on the merits.

The Amendment filed December 29, 2004, has been received and entered.

Response to Amendment

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5 are rendered vague and indefinite for not clearly setting forth how the method is carried out with respect to the step of administering. It is unclear how the mixture is being given to the patient? Is it done by injection of orally? The metes and bounds of the claims can not be determined. It is suggested to insert –orally—before "administering" at line 2 of claims 1 and 5; or it is suggested to insert the limitation of claims 8 and 9 into claims 1 and 5, respectively, and of course cancel claims 8 and 9. Furthermore, it is unclear what the active ingredient is per se as newly recited in claim 3. How can ion-exchange capacity be an active ingredient? The phraseology in the claim 3 is very confusing. The phrase "as an active ingredient" would be better placed after after "mixture of herbs" or better yet still perhaps to delete the phrase entirely. Also claim 5 recites "weigh" at the end of the claim and this renders the claims 5-7 and 9 grammatically indefinite.

Response to Arguments

Applicant's arguments filed December 29, 2004, have been fully considered but they are not persuasive. The arguments that the amendment remedies the rejections of record are noted but for reasons discussed above the rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Giampapa, cited on enclosed copy of PTO-1449 Form, as US Patent No. 5,895,652.

Claims are drawn to a method for activating adenosine triphosphate (ATP) synthesis comprising the step of administering to a patient an effective amount of herbs selected from grape seeds orally or parenterally.

Giampapa teaches a method for comprising the step of orally administering to a patient an effective amount of herbs selected from grape seeds. See column 10, lines 56-57.

The claims appear to be identical to the cited disclosure are considered to be anticipated by the teachings therein. The step required of the method is clearly disclosed as is the active ingredient. Further, the synthesis of ATP is inherent to the step disclosed by Giampapa in that when a patient is given the herb ATP would inherent

be synthesized because Giampapa teaches that grape seed extract functions to maximize the body's inherent biochemical pathways, see column 4, lines 35-45.

Response to Arguments

Applicant's arguments filed December 29, 2004, have been fully considered but they are not persuasive. The argument that grape seeds has been removed from the Markush Group is noted, however, this particular argument only applies to claim 3 and not claim 1. Claim 1 remains to be anticipated by the teachings of Giampapa for reasons of record. Further, claim 8 is also anticipated because Giampapa teach oral administration, note the abstract wherein the mixture is disclosed to be a comestible.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 3 is rejected under 35 U.S.C. 102(e) as being anticipated by **newly recited** Tuttle, see the enclosed PTO-892 Form.

The claim is newly drawn to a method for activating ATP synthesis comprising the step of administering to a patient an effective amount of a mixture of herbs having an ion-exchange capacity wherein the herbs are selected from Acanthopanax senticosus.

Tuttle teaches method for activating ATP synthesis comprising the step of administering to a patient an effective amount of a mixture of herbs having an ion-exchange capacity wherein the herbs are selected from Acanthopanax senticosus. Note column 3, lines 1-3 and line 38; also see column 4, lines 14-23.

The claim is identical to the cited disclosure and is therefore considered to be anticipated by the teachings therein. For reasons noted above, the ion exchange capacity is inherent to the activity of the herbs disclosed by Tuttle.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2 and 4 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Giampapa, cited and discussed above.

The claims are further drawn to an redox potential of –300mV or less and an effective dosage amount of 5.5 mg to 17.5 mg per kg body weight of the patient and also drawn to a method for activating ATP comprising various percentage weight amounts of the

Giampapa, in addition teaches that an amount of 20 mg per body weight of the grape seed extract may be give. Also oxidation-reduction potential is well known to be part of the biochemical pathways of the body. Note the above references in the Giampapa patent. Also see the abstract.

The claims differ from Giampapa in that the redox potential range of 300 mV or less and dosage ranges are not specifically disclosed.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to optimize the dosages disclosed by Giampapa in accordance with the body weight of a patient to obtain successful results. Since Giampapa teaches 20 mg as an effective amount, 17.5 mg would have been expected to provide successful results. Further, the redox potential of a patient's body in response to administering the effective amounts of Giampapa would have been expected to be in accordance with the biochemical pathways of the body as disclosed by Giampapa. The claims are rendered prima facie obvious over the cited prior art.

Response to Arguments

Applicant's arguments filed December 29, 2004, have been fully considered but they are not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., herbs selected from a group consisting of thyme, rosemary, turmeric, fennel, dandelion, grapeseeds, and Acanthopanax senticosus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Also the argument regarding the inherent property of grape seed extract herb, specifically its ion exchange capacity, is not deemed persuasive because the reference does teach grape seed extract of which is not required by the claims and furthermore, such herb mixture would have an ion exchange capacity, since herbal mixtures inherently possess this property. The herbs of the cited reference do have an ion exchange capacity even though the reference may be silent. Applicants have not been able to show that the herbs of the cited prior art would not have an ion exchange capacity. All of the properties of the instant claimed herbs used in the claimed method are believed to be possessed by the herbs of the cited reference. Note that the reference teaches herbs selected from grape seed, even though the instant claims do not require grape seed it is evident that the reference does teach the same herbs as claimed herein.

Claims 5-7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giampapa in view of **newly cited** Tuttle (also cited above) and **newly cited** Chen, both newly cited reference cited on enclosed PTO-892 Form.

Claims are newly drawn to a method for activating ATP comprising the step of administering to a patient orally or parenterally, an effective amount of a mixture of herbs in percentage amounts: 8-12% thyme, rosemary, turmeric and dandelion; 13-17% of fennel and grape seeds; and 25-35% Acanthopanax senticosus.

Giampapa and Tuttle are discussed above.

Chen teaches all of the other herbs that Giampapa and Tuttle do not teach: fennel, dandelion, rosemary, turmeric, and thyme, note column 10, lines 19, 25, 45, and 52.

The claims differ from Giampapa in that Acanthopanax senticosus and fennel, dandelion, rosemary, turmeric, and thyme are not taught.

It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select for grape seed extract as disclosed by Giampapa, and Acanthopanax senticosus as disclosed by Tuttle, and fennel, dandelion, rosemary, turmeric, and thyme as taught by Chen in order to provide for a herb mixture for activating ATP. Tuttle clearly teaches that ATP synthesis is activating when taking herbs orally. One of skill would have expected successful results and the prior art would have motivated one of skill in the art to select for these herbs. Furthermore, to optimize percentage amounts of these herbs is clearly within the skill of an skilled artisan. The amounts are obvious modifications of the selected herbs for use as an active ingredient. Further, the redox potential and dosage amount are well within the skill of an artisan to determine and the dosage amount would provide guidance for an acceptable redox potential for a patient's body. The claims are prima facie obvious.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

All claims fail to be patentably distinguishable over the state of the art discussed above and cited on the enclosed PTO-892 and/or PTO-1449. Therefore, the claims are properly rejected.

The remaining references listed on the enclosed PTO-892 and/or PTO-1449 are cited to further show the state of the art.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 571-272-0924. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEBORAH K. WARE
PATENT EXAMINER

Deborah K. Ware
April 1, 2005

DAVID M. NAFF
PRIMARY EXAMINER
ART UNIT 1651